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In the Supreme Court of the United States

OCTOBER TERM, 1964

No. 871

KAROLINE CAUER ET AL, HEIRS OF WILHELM ADOLF CAUER, DECEASED,
PETITIONERS,

v.

EDWARD J. BRENNER, COMMISSIONER OF PATENTS,
RESPONDENT.
(IN THE MATTER OF THE PATENT APPLICATION OF WILHELM ADOLF CAUER, DECEASED)

PETITIONERS' REPLY BRIEF

ROBERT H. RINES
DAVID RINES
No. Ten Post Office Square
Boston 9, Massachusetts
NELSON H. SHAPIRO
640 Washington Building
15th and New York Avenue
Washington 5, D. C.
Attorneys for the Petitioners

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PETITIONERS' REPLY BRIEF

In his brief for the respondent, the Solicitor General has conceded that petitioners' first question with regard to the jurisdiction of the Supreme Court to review, by certiorari, patent decisions of the Court of Customs and Patent Appeals "is important and should be resolved by this Court" (p. 5).

This same issue, indeed, is stressed in a copending petition in which the Solicitor General has asked this Court to take jurisdiction, *Edward J. Brenner, Commissioner of Patents, Petitioner* v. *Andrew John Manson*, No. 932,

October Term 1964.[1] The same issue is also presented in another petition presently before this Court, *In the Matter Of The Application Of Homer G. Thomson,* Oct. Term, 1964.

But the Solicitor General feels that this Court should not resolve this question in connection with the present petition because the second question presented by that petition, in view of the Solicitor, "does not warrant review by this Court".

As erroneously worded in the second question presented by the Solicitor, your petitioners would agree; but as correctly worded in your petitioners' second question, your petitioners urge that it is also for the Supreme Court to determine whether all Article III courts have powers and duties of judicial notice, or whether the Court of Customs and Patent Appeals—though now an Article III court—is forbidden by 35 U.S.C. 144, *as it has specifically held in the present cause*, even to consider parts of the legislative history of a statute and published rulings of the Department of Justice that were not part of the written "record" in the Patent Office.

As for the merits of the present litigation, if the Court had the duty and the power to consider all of the legislative history, and not just what was in the "record" in the Patent Office, it is not disputed but that, in actual fact, the Secretary of Commerce had been turned down by Congress in an effort to change the phrase "invention made" to the broader "technological information" meaning applied by the Court of Customs and Patent Appeals.

Thus, the statute must be construed as "*invention made*" and not just any "technological information", unless the

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[1] Note that the Solicitor General now says this Court *has* jurisdiction; whereas some months ago, the Solicitor urged this Court not to hear an extraordinary writ of your petitioners (*Karoline Cauer et al* v. *The Honorable Justices of the United States Court of Customs and Patent Appeals*, No. 268., Oct. Term, 1963), taking just the opposite view that the Supreme Court had *no* such jurisdiction!

Court of Customs and Patent Appeals is correct that 35 U.S.C. 144 forbids it to consider legislative history "not part of the record" in the Patent Office and thus the will of Congress is to be thwarted.

So, also, in what the Court of Customs and Patent Appeals deems its absence of power to take judicial notice of published rulings of government agencies "not part of the record" in the Patent Office, that court held that the patent application oath that Professor Cauer was at one time a "citizen of Germany" meant that he was prohibited from filing a patent application.

In actual fact, the published decisions of the Justice Department recognizing the religious persecution to which Dr. Cauer was subjected—and which the Solicitor General *now admits* in his brief, p. 7—show clearly that Dr. Cauer, under the laws and decrees of Germany did *not* have the full attributes of German Nationality and therefore was not a "German National" within the meaning and intent of PL380.

An article III court would have the power to take notice of these decisions of the Justice Department, which occurred after the proceedings in the Patent Office, but the Court of Customs and Patent Appeals feels it cannot do so under 35 U.S.C. 144.

This question of the jurisdiction of the Court of Customs and Patent Appeals (also raised in said copending *Homer G. Thomson* petition), like petitioners' first question, appears to be an important jurisdictional question promptly to be settled, also, once and for all, so that granting of the petition is earnestly solicited.

Respectfully submitted,

ROBERT H. RINES
DAVID RINES
No. Ten Post Office Square
Boston 9, Massachusetts
NELSON H. SHAPIRO
640 Washington Building
15th and New York Avenue
Washington 5, D. C.
Attorneys for the Petitioners